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10/653,691	09/02/2003	Taku Oikawa	9333-356	3491

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EXAMINER
CHOI, MICHAEL P

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/653,691	OIKAWA, TAKU
Office Action Summary	Examiner	Art Unit	
	Michael P. Choi	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 November 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 September 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>9/2/03, 11/17/06</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites the limitation " the music-piece playback instruction section".   There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1, 15-17, 19, 21-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando et al. (US 2001/0046371 A1).

Regarding Claim 1, Ando et al. (hereinafter Ando) teaches a video disk player for playing back a disk containing a plurality of music pieces, each recorded as a combination of video data and corresponding audio data, comprising:

- a video-data output section (Fig. 14 – wherein the output is a PC or TV) for sequentially playing back video data (Fig. 6A – slideshow sequential) of a plurality of music pieces recorded in the disk (in at least Fig. 7), each for a predetermined time interval (Fig. 7 – audio track no. 1 having a set period), upon receipt of at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer); and

- an audio-data output section for playing audio data (Fig. 14 – audio output from decoder unit, 402) of at least one music piece different from at least some of the music pieces whose video data is played back (in at least Fig. 7 – audio object #1 different than audio objects), upon receipt of the search signal (in at least Fig. 1 – CI search pointer).

Regarding Claim 15, Ando teaches the video disk player according to claim 1, wherein the audio-data output section comprises a music-piece playback instruction section for identifying a music piece previously selected from the plurality of recorded music pieces and set by an operator (Fig. 28B – having an index within user defined program chain; Page 17, Paragraphs [0335+]).

Regarding Claim 16, Ando teaches the video disk player according to claim 15, wherein said at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for selecting a function for playing back audio data of a music piece different from the music pieces whose video data is played back (Fig. 1 – track head entry point #1) and another signal for selecting another function (Fig. 1 – track head entry point #2...), and wherein, upon receipt of the search signal for selecting the other function (in at least Fig. 1 – CI search pointer), video data and audio data of each of the music pieces recorded in the disk are played back in combination for a predetermined time interval in the order of the music pieces in the disk (Page 6, Paragraph [0129+]).

Regarding Claim 17, Ando teaches the video disk player according to claim 1, wherein said at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for selecting a function for playing back audio data of a music piece different from the music pieces whose video.data is played back (Fig. 1 – track head entry point #1) and another signal for selecting another function (Fig. 1 – track head entry point #2...), and wherein, upon receipt of the search signal for selecting the other function (in at least Fig. 1 – CI search pointer), video data and audio data of each of the music pieces recorded in the disk are played back in combination for a predetermined time interval in the order of the music pieces in the disk (Page 6, Paragraph [0129+]).

Regarding Claim 19, Ando teaches the video disk player according to claim 1, wherein a DVD-audio is used as the disk (Fig. 2; Page 2, Paragraphs 0029]).

Regarding Claim 21, Ando teaches that in a video disk player, a method for playing back a disk containing a plurality of music pieces, each recorded as a combination of video data and corresponding audio data, comprising:

- sequentially playing back video data of a plurality of music pieces recorded in the disk (Page 6, Paragraph [0129+]), each for a predetermined time interval (Fig. 1 – having audio track with a beginning and an end; Fig. 25, S77), upon receipt of at least one search signal for searching the music pieces recorded in the disk (Fig. 25, S77 – corresponding audio track); and
- playing audio data of at least one music piece different from at least some of the music pieces whose video data is played back (Page 6, Paragraph [0129+]; Fig. 1 – audio track no.1 differing from audio track no.2), upon receipt of the search signal (Fig. 1 – CI Search Pointer).

Regarding Claim 22, Ando teaches the method according to claim 21, wherein the at least one music piece whose audio data is played is previously selected from the plurality of recorded music pieces (in at least Figs. 1 and 7 – audio track no.1 played among the other audio tracks) and set by an operator (Page 6, Paragraph [0133+] – user defined PGC).

Regarding Claim 23, Ando teaches the method according to claim 22, wherein the music-piece playback instruction section identifies a predetermined specific music piece when no music piece is set by an operator (Page 6, Paragraph [0132] – playing in order).

Regarding Claim 24, Ando teaches the method according to claim 21, wherein the at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for playing back audio data of a music piece different from the music pieces whose

video data is played back (Fig. 1 – track head entry point #1) and another signal (Fig. 1 – track head entry

point #2...) for which video data and audio data of each of the music pieces recorded in the disk are

played back in combination for a predetermined time interval in the recorded order of the music pieces in

the disk (Page 6, Paragraph [0129+]).

Regarding Claim 27, Ando teaches the method according to claim 21, wherein a DVD-audio is

used as the disk (Fig. 2; Page 2, Paragraphs 0029]).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 2-4, 6-14, 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ando et al. (US 2001/0046371 A1) in view of Yamamoto et al. (US 2002/0051625 A1).

Regarding Claim 2, Ando teaches the video disk player according to claim 1, wherein the audio-

data output section comprises a memory for recording the video data and the corresponding audio data of

the disk (Fig.14 – memory, 426), and, upon receipt of the search signal, but fails to explicitly teach that

only the audio data of the video and audio data recorded in the memory is played back. Yamamoto et al.

teaches only the audio data of the video and audio data recorded in the memory is played back (in at

least Page 5, Paragraphs [0068, 0073-0076]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to

combine the video disk player to playback only the audio data to create a simpler design of not having to

produce a video screen for video playback and thereby eliminating the need for a large display coupled or integrated with an audio player.

Regarding Claim 3, Ando teaches the video disk player according to claim 2, wherein the audio-data output section comprises a music-piece playback instruction section for identifying a music piece previously selected from the plurality of recorded music pieces and set by an operator (Fig. 28B – having an index within user defined program chain; Page 17, Paragraphs [0335+]).

Regarding Claim 4, Ando teaches the video disk player according to claim 3, wherein the at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for selecting a function for playing back audio data of a music piece different from the music pieces whose video data is played back (Fig. 1 – track head entry point #1) and another signal for selecting another function (Fig. 1 – track head entry point #2...), and wherein, upon receipt of the search signal for selecting the other function (in at least Fig. 1 – CI search pointer), video data and audio data of each of the music pieces recorded in the disk are played back in combination for a predetermined time interval in the recorded order of the music pieces in the disk (Page 6, Paragraph [0129+]).

Regarding Claim 6, Ando teaches the video disk player according to claim 1, wherein the audio-data output section comprises a memory (Fig.14 – memory, 426), and the audio data recorded in the memory is played (Page 6, Paragraph [0129+]) upon receipt of the search signal (in at least Fig. 1 – CI search pointer) but fails to explicitly teaches recording only audio data of the disk. Yamamoto et al. teaches recording only audio data of the disk (Page 1, Paragraph [004]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the memory to record only the audio data since it is a readily available component (as seen in Page 1, Paragraph [004] and mentioned as prior art) as well as to create a larger capacity, since there is no recording of video.

Regarding Claim 7, Ando teaches the video disk player according to claim 6, further comprising a data processor, wherein the audio data to be recorded in the memory (Fig. 14 – D-Pro; Page 11, Paragraphs [0214+]) is separated from a combination of video data and corresponding audio data (Fig. 1 – VR_MOVIE OBJECT Recording Area as opposed to AR_AUDIO OBJECT Recording Area) of a music piece different from the music pieces whose video data is played back and which are taken in from the data processor (in at least Fig. 1 – having Audio Track No.1 and No. 2 and No.3).

Regarding Claim 8, Ando teaches the video disk player according to claim 7, wherein the audio-data output section comprises a music-piece playback instruction section for identifying a music piece previously selected from the plurality of recorded music pieces and set by an operator (Fig. 28B – having an index within user defined program chain; Page 17, Paragraphs [0335+]).

Regarding Claim 9, Ando teaches the video disk player according to claim 8, wherein said at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for selecting a function for playing back audio data of a music piece different from the music pieces whose video data is played back (Fig. 1 – track head entry point #1) and another signal for selecting another function (Fig. 1 – track head entry point #2...), and wherein, upon receipt of the search signal for selecting the other function (in at least Fig. 1 – CI search pointer), video data and audio data of each of the music pieces recorded in the disk are played back in combination for a predetermined time interval in the order of the music pieces in the disk (Page 6, Paragraph [0129+]).

Regarding Claim 10, Ando teaches the video disk player according to claim 8, wherein the music-piece playback instruction section identifies a predetermined specific music piece when no music piece is set by an operator (Fig. 7 – having an original program chain and no user defined program chain; Page 7, Paragraphs [0152+]).

Regarding Claim 11, Ando teaches the video disk player according to claim 10, wherein said at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for selecting a function for playing back audio data of a music piece different from the music pieces whose video data is played back (Fig. 1 – track head entry point #1) and another signal for selecting another function (Fig. 1 – track head entry point #2...), and wherein, upon receipt of the search signal for selecting the other function (in at least Fig. 1 – CI search pointer), video data and audio data of each of the music pieces recorded in the disk are played back in combination for a predetermined time interval in the order of the music pieces in the disk (Page 6, Paragraph [0129+]).

Regarding Claim 12, Ando teaches the video disk player according to claim 6, further comprising a data processor, wherein the audio data to be recorded in the memory is that separated by the data processor (Fig. 14 – D-Pro; Page 11, Paragraphs [0214+]).

Regarding Claim 13, Ando teaches the video disk player according to claim 12, wherein the audio-data output section comprises a music-piece playback instruction section for identifying a music piece previously selected from the plurality of recorded music pieces and set by an operator (Fig. 28B – having an index within user defined program chain; Page 17, Paragraphs [0335+]).

Regarding Claim 14, Ando teaches the video disk player according to claim 13, wherein said at least one search signal for searching the music pieces recorded in the disk (in at least Fig. 1 – CI search pointer) includes a signal for selecting a function for playing back audio data of a music piece different from the music pieces whose video data is played back (Fig. 1 – track head entry point #1) and another signal for selecting another function (Fig. 1 – track head entry point #2...), and wherein, upon receipt of the search signal for selecting the other function (in at least Fig. 1 – CI search pointer), video data and audio data of each of the music pieces recorded in the disk are played back in combination for a predetermined time interval in the order of the music pieces in the disk (Page 6, Paragraph [0129+]).

Regarding Claim 18, Ando teaches the video disk player according to claim 1, but fails to explicitly teach wherein a DVD-video is used as the disk. Yamamoto et al. teaches a DVD-video is used as the disk (Page 1, Paragraph [0004]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a DVD-video used as the disk since it is a readily available component (as seen in Page 1, Paragraph [004] and mentioned as prior art) as well as increasing the versatility to play video as well as audio.

Regarding Claim 26, Ando teaches the method according to claim 21, but fails to explicitly teach wherein a DVD-video is used as the disk. Yamamoto et al. teaches a DVD-video is used as the disk (Page 1, Paragraph [0004]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a DVD-video used as the disk since it is a readily available component (as seen in Page 1, Paragraph [004] and mentioned as prior art) as well as increasing the versatility to play video as well as audio.

7.   Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US 2001/0046371 A1) in view of Kawabata et al. (US 5,170,159).

Regarding Claim 20, Ando teaches the video disk player according to claim 1 having music pieces contained in the disk is sequentially played back (Page 6, Paragraph [0129+]) but fails to explicitly teach wherein the video-data output section comprises a playback time-interval setting section for arbitrarily setting a time interval. Kawabata et al. teaches the video-data output section comprises a playback time-interval setting section for arbitrarily setting a time interval (Fig. 2; Col. 1, Lines 7-12, 36+; Col. 2, Lines 25+ - sleep timer having a timer).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a timer to combine the video disk player with a playback time-interval setting section so as to allow user to hear snippets and music clips of each audio track.

Regarding Claim 25, Ando teaches the method according to claim 21 having the music pieces contained in the disk is sequentially played back (Page 6, Paragraph [0129+]), but fails to explicitly teach wherein further comprising setting a time interval. Kawabata et al. teaches the method further comprising setting a time interval (Col. 1, Lines 7-12, 36+; Col. 2, Lines 25+ - sleep timer having a timer by pressing a button).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a timer to combine the video disk player with a playback time-interval setting section so as to allow user to hear snippets and music clips of each audio track.

8.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ando et al. (US 2001/0046371 A1) in view of Yamamoto et al. (US 2002/0051625 A1) in further view of Kawabata et al. (US 5,170,159).

Regarding Claim 5, Ando teaches the video disk player according to claim 4 having music pieces contained in the disk is sequentially played back (Page 6, Paragraph [0129+]) but fails to explicitly teach wherein the video-data output section comprises a playback time-interval setting section for arbitrarily setting a time interval. Kawabata et al. teaches the video-data output section comprises a playback time-interval setting section for arbitrarily setting a time interval (Fig. 2; Col. 1, Lines 7-12, 36+; Col. 2, Lines 25+ - sleep timer having a timer).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a timer to combine the video disk player with a playback time-interval setting section so as to allow user to hear snippets and music clips of each audio track.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
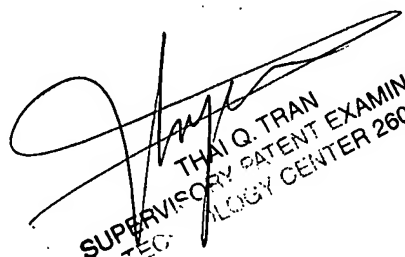
- US 6,222,983 B1 – DVD-audio disk, apparatus, and method for playing.

- US 6,745,164 B2 – DVD-audio playback method and device

- US 6,931,200 B1 – Optical disc playback apparatus and method

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Choi whose telephone number is (571) 272-9594. The examiner can normally be reached on Monday - Friday 8:00AM - 5:30PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MC